51783

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of		:	PATENT
	Volkmar KLEIN et al.	:	
Serial No.: 10/589,964		:	Art Unit: 1797
Filed:	August 18, 2006	:	Examiner: M. Gonzalez
For:	FILTER DEVICE	:	Appeal No. _____

BRIEF ON APPEAL

Mark S. Bicks, Esquire
Roylance, Abrams, Berdo & Goodman, LLP
1300 19th Street, N.W., Suite 600
Washington, D.C. 20036
(202) 659-9076

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APPELLANT BRIEF
ON APPEAL UNDER 37 C.F.R. §41.37

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

For the appeal to the Board of Patent Appeals and Interferences from the decisions dated July 17, 2009 and October 1, 2009 of the Primary Examiner twice and finally rejecting claims 11, 12 and 14-26 in connection with the above-identified application, Applicant-Appellant submits the following brief in accordance with 37 CFR §41.37.

1. Real Party in Interest

The inventors, Volkmar Klein and Norbert Sann, assigned their entire rights, titles and interests in the patent application to Hydac Filtertechnik GmbH of Sulzbach/Saar, Germany.

2. Related Appeals and Interferences

There are no other related appeals or interferences known to Appellants, Appellants' legal representative, or assignees, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

3. Status of Claims

Claims 1-10 and 13 are cancelled. Claims 11, 12 and 14-26 are pending, are rejected, and are on appeal.

4. Status of Amendments

Subsequent to the July 17, 2009 Office Action containing the final rejection, a September 16, 2009 Response was filed that did not amend the specification or claims. An October 1, 2009 Advisory Action entered and considered that Response, but held that the Response did not avoid the rejections under 35 U.S.C. §§102 and 103.

5. Summary of Claimed Subject Matter

Sole independent claim 11 covers a filter device having a filter housing 22, a filter element 10, a fluid container 40 and a connector 44 (p. 4, line 20; p. 5, lines 11-15; Figs. 1, 2 and 3A-3C). The filter housing 22 has fluid connections 30 and 36 and an exterior surface (p. 4, lines 24-26; p. 5, lines 1-3; Fig. 1). The filter element 10 is held in the filter housing 22 (p. 4, line 20; Fig. 1). The fluid container 40 also has an exterior surface, and is located adjacent to and side-by-side with the filter housing 22 to define a lateral space therebetween (p. 6, lines 19-24; Figs. 2, 3B and 3C). The connector 44 couples the fluid connections 30, 36 to the fluid container 40, and has at least one longitudinally displaceable blocking part 46 blocking the fluid connections

30, 36 in a blocking position (p. 5, line 20, to p. 6, line 3; Figs. 1, 3A and 3B) and opening the fluid connections 30, 36 in an open position thereof (p. 6, lines 4-12; Figs. 2 and 3C). The blocking part 46 is located between and accessible from the exterior surfaces of the filter housing 22 and the fluid container 40 when the filter housing 22 and the fluid container 40 are coupled by the connector 44, and includes a plate-shaped sliding valve part guided for movement between and sealed between first and second connecting plates 42, 48 of the connector 40 by seals 50 facing the filter housing and facing the fluid container (p. 5, line 11, to p. 6, line 11; Figs. 1 and 2). The connector 44 with the blocking part 46 is located in the lateral space with the filter housing 22 and the fluid container 40 being on opposite sides of the connector 44 (p. 5, lines 11-19; Figs. 1-2 and 3A-3C).

By forming the filter device in this manner, the connector 44 can be simply formed and operated. Particularly, the blocking part 46 can be operated independent of movement of the filter device and the fluid container, and is sealed to and guided by both connecting plates 42, 48 of the connector 44 during movement of the blocking part 46 in the lateral space between the filter housing 22 and the fluid container 40.

6. Grounds for Rejection to be Reviewed Upon Appeal

Claims 11, 12, 14, 15, 18-20 and 23-26 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,982,520 to Wheeler in view of German patent number 31 00 499.

Claims 16 and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over the Wheeler patent in view of the German patent, when further considered in view of U.S. Patent No. 6,485,635 to Gandini.

Claim 21 stands rejected under 35 U.S.C. §103 as being unpatentable over the Wheeler patent and the German patent, when further considered in view of U.S. Patent No. 5,256,285 to Tomita.

Claim 22 stands rejected under 35 U.S.C. §103 as being unpatentable over the Wheeler patent in view of the German patent when further considered in view of U.S. Patent No. 6,579,455 to Muzik.

7. Arguments

A. Rejections Under 35 U.S.C. §103 Based on Wheeler and German Patents

(1) The Rejection

Claims 11, 12, 14, 15, 18-20 and 23-26 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,982,520 to Wheeler in view of German patent number 31 00 499. Relative to claim 11, the Wheeler patent is cited for disclosing a filter device having a filter housing 26 with fluid connections on its exterior surface, a filter element in the filter housing, a fluid container 24 having an exterior surface and located adjacent to and side-by-side with the filter housing, and a connector 20 coupling the fluid connections to the container 24 with the connector having at least one displaceable blocking part 60. The blocking part is allegedly located between and accessible from the exterior surface of filter housing 26 and fluid container 24 when the filter housing and the fluid container are coupled by the connector 20. Additionally, the blocking part allegedly has a sliding valve part guided for movement between connecting plates 20, 22 of connector 20 by seals 38, 56 facing the filter housing and facing the fluid container. The fluid connector with its blocking parts is allegedly located in the lateral space between filter housing 26 and fluid container 24 that are on opposite sides of the connector 20.

The cited German patent is cited for a filter device, including plate-shaped valves 10, 11, 12, longitudinally displaceable to open the fluid passages. In support of the rejection, it is alleged that it would be obvious to provide the Wheeler device with the German patent valves to open and close the passage, with the translation being relied upon for teaching that rotational longitudinal movements of valves are common. Further, it is allegedly obvious to make the Wheeler valves plate-shaped, as taught by the German patent.

Relative to claim 12, the hydraulic tank is held not to patentably distinguish the art based on it allegedly being a mere statement of use. Relative to claim 14, the Wheeler connecting plates allegedly include fluid passages, and the blocking part allegedly has wall parts that cover the fluid connections in blocking positions and openings clear of the fluid connections in the open position. Relative to claim 15, the Wheeler device allegedly has an inlet and an outlet located on top of one another in the direction of the longitudinal axis and are adjacent one another directly on the exterior surface of the filter housing with the fluid passages also being arranged in that manner and with the blocking part allegedly having openings 64 and 62 between wall parts. Relative to claim 18, the filter housing connections are allegedly on an outer peripheral side, and the connector 20 allegedly has flange parts 72, 70 on a connecting plate, with the connecting plate having fluid passages therein encompassed by the flange parts. Relative to claim 19, the Wheeler attachment part allegedly includes a locking part 69 received in an opening in one of the flange parts and a locking part received in a recess in the blocking part in the opening with the locking part 69 received in the blocking part recess. Relative to claim 20, the locking device is a pin 69. Relative to claim 23, the German patent allegedly discloses the blocking plate that moves translationally. Relative to claim 24, the German patent is cited for fluid connections perpendicular to the filter housing longitudinal axis. Relative to claim 25, the

Wheeler part allegedly has a blocking part with two openings and two wall parts. Relative to claim 26, the Wheeler patent allegedly has two openings and two wall parts that are fixedly connected for simultaneous movement.

(2) Claim 11 is Patentably Distinguishable by the Plate-Shaped Sliding Valve Part Guided for Longitudinal Movement Laterally Between the Filter Housing and the Fluid Container

Relative to claim 11, neither the Wheeler patent nor the German patent have a plate-shaped sliding valve part guided for longitudinal movement. The Wheeler patent has a rotary stem valve 60. The German patent valves move perpendicularly to their longitudinal extent, not along their longitudinal extent in order to be longitudinally displaceable as recited in claim 11. Moreover, if the German patent valves were used in the Wheeler device, the rotational knobs 17 necessary to operate the device would be located either in the filter housing 26 or in the combustion engine 24 causing the knob to be inaccessible and rendering the device proposed by the combination inoperative for its intended purpose. Such inoperativeness indicates that the rejection is unpatentable.

Additionally, claim 11 recites that the fluid container and the filter housing are "side-by-side" with the blocking part in the lateral space therebetween. In contrast, the Wheeler filter housing 26 and fluid container 24 are located end-to-end. The terms "end" and "side" are not interchangeable, particularly within the context of this application. The German patent also fails to disclose or teach this feature.

The Wheeler oil filter mounting means comprises an adapter member 20 attached by a one-piece fitting 22 at one end to a combustion engine 24 and by a seal member 38 to a filter cartridge 26 at its opposite end. The valving consists of a rotary valve stem 60 extending into a bore arranged perpendicularly to the longitudinal extend of adapter member 20 and having

passageways 62 and 64 opening and closing adapter member conduits 52 and 54 depending on the rotational position of valve stem 60. Conduits 50 and 54 are open when aligned with passageways 62 and 64, and closed when they are not aligned. The valve stem 60 is rotated by a thumb lever 69 about the longitudinal axis of the valve stem, which longitudinal axis is perpendicular to the longitudinal axis of adapter member 20. Thumb lever 69 is on the exposed axial end of valve stem 60. Thus, the wheel rotary valve stem 60 is not a plate-shaped valve part guided for longitudinal movement between connecting plates, and is not located between a side-by-side filter housing and fluid container, as recited in claim 11.

The German patent discloses a filter housing 6 with a filter element 9 therein, and with a filter inlet 4 and a filter outlet 5 at the filter housing upper end. A valve structure is mounted on the top end of the filter housing, and has an inlet 2, an outlet 3, valves 10, 11, 12 and a by-pass 15. Valves 10, 11 and 12 operate filter inlet 4, by-pass 15 and filter outlet 15, respectively, to control the independent flow of fluid flow through inlet 4, outlet 5 and by-pass 15. Each of the three valves has a knob 17 located on the vertical upper end of each valve remote from filter housing 6. The valves are rotated and axially advanced by a threaded connection operated by the respective rotational knob 17 to move in a direction perpendicular to the valve plates thereof as the plates are rotated.

If the Wheeler valve is made displaceable, as allegedly taught in the German patent, the modified Wheeler valve would have multiple parts that move vertically in the position illustrated in Wheeler patent Fig. 3 to open and close conduits 50 and 54 since the German patent valve plates only move up and down relative to a vertical passage. Such movement would not be between and guided by two connecting plates, as recited in claim 11, and would not be operable as noted above. No two connecting plates are provided in the Wheeler connector 20.

The proposed modification involves making the Wheeler valve stem 60 displaceable longitudinally and in a plate-shaped configuration as allegedly taught by the German patent. However, making the Wheeler valve stem longitudinally displaceable and plate-shaped as disclosed in the German patent would require that the modified Wheeler valve arrangement operate on the top ends of Wheeler conduits 50 and 54 that are adjacent its filter cartridge 26. In such location, the handles would have to be inside the Wheeler filter cartridge and inaccessible to the user, rendering the proposed device inoperative. The German plate does not disclose, teach or render obvious valve plate movement perpendicular to the conduits or passages being opened and closed. Nothing in the record supports the allegation that the German patent broadly teaches longitudinal movement of valve parts regardless of the relative orientation of the conduits being opened and closed.

A rejection based upon a modification of a reference that destroys the intent and function of the invention disclosed in the reference is not proper. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Thus, the Wheeler and German patents do not render the subject matter of claim 11 obvious, and neither one discloses nor renders obvious considered alone or in combination the noted distinguishing features of claim 11.

When no reference discloses a feature of a claim relied on to distinguish the prior art, there can be no suggestion to modify the prior art to contain that feature. In re Civitello, 339 F.2d 243, 144 USPQ 10 (C.C.P.A. 1964). As stated in W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 USPQ 303, 311 (Fed. Cir. 1983), there must be something in the teachings of the cited patents to suggest or to provide a reason to one skilled in the art that the claimed invention would be obvious.

Despite the simple concept of the invention, the Examiner has the burden of finding "the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed." See In re Werner Kotzab, 217 F.3d 1365, 1371, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). Here, the necessary factual findings are missing, rendering the rejection untenable.

The Examiner, in this situation has not pointed to any specific principle or motivation in the prior art that would lead one skilled in the art to arrive at the invention as claimed. "[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Werner Kotzab, 217 F.3d at 1371, 55 USPQ 2d at 1318. If no particular finding can be made as to the reason one skilled in the art would have used the features of the German patent in the Wheeler device to produce the claimed invention, the Examiner cannot properly hold the claimed invention obvious.

The Examiner is using the Examiner's knowledge of the invention, in hindsight, to conclude improperly that one skilled in the art would have found it obvious to make the proposed combinations and modifications. However, such "hindsight reconstruction" is impermissible in reaching a finding of obviousness. See, e.g., W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

(3) Dependent Claims 12, 14, 15, 18-20 and 23-26

Claims 12, 14, 15, 18-20 and 23-26, being dependent upon claim 11, are also allowable for the above reasons. Moreover, these dependent claims are further distinguished by the additional limitations recited therein.

(a) Claim 12

Claim 12 is further distinguishable by the fluid container comprising a hydraulic tank, particularly within the overall claim combination. The recitation of a hydraulic tank is structural, not a statement of use. Clearly, there is nothing to indicate that the Wheeler internal combustion engine 24 can be considered and perform as a hydraulic tank.

(b) Claim 14

Claim 14 is further distinguishable by the fluid inlet and outlet, the fluid passages in the connecting plates and the blocking part having wall parts, as claimed. Such features are not anticipated or rendered obvious by the Wheeler and German patents, since no openings in the German patent valve plates, proposed to be used in the Wheeler device instead of rotary stem valve 60, clear the fluid connections. The valve movement of the German patent device is along the axis of the conduits, not perpendicular to those conduits. Nothing in the record supports the allegation that the German patent teachings are obvious to apply to the Wheeler patent for the Wheeler valve stem 60 to move along its longitudinal axis perpendicular to conduits 50, 54.

(c) Claim 15

Claim 15 is further distinguishable by the fluid inlet and outlet and the fluid passages being located one of top of another. In contrast, the Wheeler device has the passages laterally spaced and parallel to the longitudinal axis of the filter housing, and not one on top of each other in the direction of the filter housing. The Examiner's interpretation of the Wheeler longitudinal axis being horizontal is arbitrary, merely conclusionary and without factual basis. Similarly, the various fluid passages in the German patent are located along a direction transverse to the longitudinal axis of the filter housing, not in the direction of the longitudinal axis, as clearly

recited in claim 15. Further, the alleged German patent blocking parts 10-12 does not have the claimed clearance openings.

(d) Claim 18

Claim 18 is further distinguishable by the fluid connections being on the outer peripheral side of the filter housing and by the attachment part 64 and the flange parts 66. This claim specifically recites that the filter housing connection is "on an outer peripheral side" of the filter housing to place this feature into the claim, contrary to the Examiner's allegation. The Wheeler fluid connections are on the bottom of the filter housing, not the lateral side. Outer surface 72 and cylindrical nipple 70 of the Wheeler patent do not provide the claimed flange parts encompassing the fluid passages.

(e) Claim 19

Claim 19 is further distinguishable by the locking part 68 with its mating opening 72 in one of the flange parts and the recess in the blocking part, with the locking part, opening and recess extending transversely to the movement direction of the blocking part. Wheeler thumb lever 69 merely provides a handle and is not a locking part received in the flange part and the blocking part, as alleged.

(f) Claim 20

Claim 20 is further distinguishable by the locking device being a locking pin 68. Wheeler part 69 not a locking pin, as claimed, particularly with the features of claim 19.

(g) Claim 23

Claim 23 is further distinguishable by the blocking part moving translationally between its blocking and open positions. Since Wheeler rotary stem valve 60 and the German patent plates of valves 10-12 each rotate, they do not move translationally, as claimed. Translational

movement must be without rotation. Movement in a straight line with rotation is not translational.

(h) Claim 24

Claim 24 is further distinguishable by the fluid connections extending perpendicular to the longitudinal axis of the filter housing. The Wheeler fluid connections extend parallel to the longitudinal axis of the filter housing, not perpendicular. Nothing supports the allegation that it would obvious to modify them, as alleged.

(i) Claim 25

Claim 25 is further distinguishable by the blocking part having two openings and two wall parts. No openings are provided in the German patent valve parts that are substituted for the Wheeler rotary valve stem 60, as alleged in the rejection.

(j) Claim 26

Claim 26 is further distinguishable by the two openings and two wall parts being fixedly connected for simultaneous movement only. The German valve parts move independently of one another, which valve parts are substituted for the Wheeler rotary valve stems 60 in the modification proposed in the rejection.

B. Rejections Under 35 U.S.C. §103 Based on Wheeler, German and Gandini Patents

(1) The Rejection

Claims 16 and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over the Wheeler patent in view of the German patent, when further considered in view of U.S. Patent No. 6,485,635 to Gandini. The Gandini patent is cited for a filter having a check valve 28 on filter element 14 and a back-flow check valve 25 in a support tube 11. In support of the rejection, it is

alleged that it would be obvious to provide the Wheeler device, as modified by the German patent, with the Gandini valves. Relative to claim 17, it is alleged that the modified device would have the valve disk, as recited in that claim.

(2) Claims 16 and 17

Claims 16 and 17, being dependent on claim 11, are also allowable for the reasons advanced above. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents.

(a) Claim 16

Claim 16 is further distinguishable by the recited valves which are separate or independent from the blocking part. The Gandini patent only discloses a single check valve 25 since part 28 is a sealing lip and not a check valve in a fluid connection of a filter housing. Thus, no disclosure of two check valves, as claimed, is provided in the cited patents.

(b) Claim 17

Claim 17 is further distinguishable by the valve disks recited therein. As noted above, the Gandini patent only teaches a single valve disk.

C. Rejection Under 35 U.S.C. §103 over Wheeler, German and Tomita Patents

(1) The Rejection

Claim 21 stands rejected under 35 U.S.C. §103 as being unpatentable over the Wheeler patent and the German patent, when further considered in view of U.S. Patent No. 5,256,285 to Tomita. The Tomita patent is cited for a device having a handle 112. In support of the rejection, it is alleged that it would be obvious to provide the Tomita handle on the Wheeler-German patent device.

(2) Claim 21

Claim 21, being dependent upon claim 11, is also allowable for the above reasons, and is further distinguishable by the additional limitation recited therein.

Claim 21 is further distinguishable by the handle on each of the filter housing and the blocking part, as specifically recited therein. The Tomita handle 112 is on cap 102, not the filter housing 106, as claimed.

D. Rejection Under 35 U.S.C. §103 Based on Wheeler, German and Muzik Patents

(1) The Rejection

Claim 22 stands rejected under 35 U.S.C. §103 as being unpatentable over the Wheeler patent in view of the German patent when further considered in view of U.S. Patent No. 6,579,455 to Muzik. The Muzik patent is cited for the materials that would allegedly be obvious to use in the Wheeler device, as modified.

(2) Claim 22

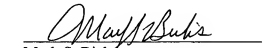
Claim 22, being dependent on claim 11, is also allowable for the above reasons, and is further distinguishable by the additional features recited therein.

Claim 22 is further distinguishable by the use of cast aluminum and steel or plastic for the various parts, particularly within the overall claim combination. The Muzik patent does not render these features obvious.

8. Conclusion

In view of the foregoing, the rejections of claims 11, 12 and 14-26 under 35 U.S.C. §103 are untenable, and a decision reversing those rejections is requested.

Respectfully submitted,



Mark S. Bicks
Reg. No. 28,770

Roylance, Abrams, Berdo & Goodman, LLP
1300 19th Street, NW, Suite 600
Washington, DC 20036
(202) 659-9076

Dated: November 5, 2009

APPENDIX A – COPY OF CLAIMS ON APPEAL

11. A filter device, comprising:

a filter housing having first and second fluid connections and an exterior surface;

a filter element held in said filter housing;

a fluid container having an exterior surface and being located adjacent to and side-by-side with said filter housing to define a lateral space therebetween; and

a connector coupling said fluid connections to said fluid container, said connector having at least one longitudinally displaceable blocking part blocking said fluid connections in a blocking position thereof and opening said fluid connections in an open position thereof, said blocking part being located between and accessible from said exterior surfaces of said filter housing and said fluid container when said filter housing and said fluid container are coupled by said connector, said blocking part including a plate-shaped sliding valve part guided for movement between and sealed between first and second connecting plates of said connector by seals facing said filter housing and facing said fluid container, said connector with said blocking part being located in said lateral space with said filter housing and said fluid container being on opposite sides of said connector.

12. A filter device according to claim 11 wherein

said fluid container comprises a hydraulic tank.

14. A filter device according to claim 11 wherein

said fluid connections comprise a fluid inlet and a fluid outlet in said filter housing;

said connecting plates comprise fluid passages corresponding to and forming part of said fluid connections; and

said blocking part has wall parts that cover said fluid connections in the blocking position and has openings that clear said fluid connections in the open position.

15. A filter device according to claim 14 wherein

said fluid inlet and said fluid outlet are located one of top of another in a direction of a longitudinal axis of said filter housing, and are adjacent one another and open directly on said exterior surface of said filter housing;

said fluid passages are located one on top of another in said direction of said longitudinal axis and are adjacent one another; and

said blocking part has clearance openings between said wall parts, said clearance openings being aligned and congruent with said fluid passages in the open position to convey fluid therethrough.

16. A filter device according to claim 11 wherein

said first and second fluid connection has first and second valves, respectively.

17. A filter device according to claim 16 wherein

said first fluid connection comprises a fluid outlet of said filter housing, with said first valve having a valve disk located on an outside of and over said fluid outlet and being independent of said blocking part; and

said fluid connection comprises a fluid inlet of said filter housing, with said second valve having a valve disk integrated within said filter inlet and being independent of said blocking part.

18. A filter device according to claim 11 wherein

said filter connections of said filter housing are encompassed on an outer peripheral side thereof by an attachment part; and

said connector has flange parts on a connecting plate thereof facing said attachment part, said connecting plate having fluid passages therein encompassed by said flange parts.

19. A filter device according to claim 18 wherein

said attachment part comprises a locking part received in an opening in one of said flange parts and in a recess in said blocking part in the open position, said locking part, said opening and said recess extending transversely to a movement direction of said blocking part.

20. A filter device according to claim 19 wherein

said locking device comprises a locking pin.

21. A filter device according to claim 11 wherein

said filter housing comprises a handle for manual operation thereof; and

said blocking part comprises a handle for manual operation thereof.

22. A filter device according to claim 11 wherein

said filter housing comprises cast aluminum; and

said blocking part comprises one of steel and plastic.

23. A filter device according to claim 11 wherein

said blocking plate moves translationally between the blocking and open positions.

24. A filter device according to claim 11 wherein

said fluid connections extend perpendicular to a longitudinal axis of said filter housing.

25. A filter device according to claim 11 wherein

said blocking part has two openings and two wall parts.

26. A filter device according to claim 25 wherein

said two openings and said two wall parts are fixedly connected for simultaneous movement thereof only.

APPENDIX B - EVIDENCE

None

APPENDIX C – RELATED PROCEEDINGS

None